

REMARKS

Claims 26 to 35 are added , and therefore claims 12 to 35 are pending in the present application.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging the priority claims and for accepting the drawings. Applicants also thank the Examiner for considering the Information Disclosure Statement of May 18, 2006.

Claims 12 to 25 were rejected under 35 U.S.C. § 102(b) as anticipated by PCT Pub. No. WO/2001/0044639 (“Matischuk”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claims 12, 13, 24 and 25 have been rewritten to provide that the second specification unit is for specifying, in the at least one operating state, the at least one output variable of the drive unit

regardless of the setpoint for the at least one output variable in the sense of approximating an actual value for the operating variable to the setpoint for the operating variable.

In the context of the claimed subject matter as to Figure 2 of the Matischuck reference, the engine torque (an output variable of the drive unit) is not drive to Msetpointres, but instead to drive to the engine speed 108 (an operating variable of the drive unit) to a specified setpoint. This claimed subject matter is not identically disclosed (or suggested) by the applied reference.

Accordingly, claims 12, 13, 24, and 25 are allowable, as are their respective dependent claims.

As further regards claim 13, as presented, it is directed to a method for operating a drive unit of a vehicle and provides for ***modifying the at least one output variable*** of the drive unit in the at least one operating state of the drive unit, ***starting from the setpoint for the at least one output variable in the sense of approximating an actual value for the operating variable to the setpoint for the operating variable.***

The Office Action refers to Matischuk (page 10, lines 5 to 15) as assertedly disclosing the above-quoted feature. The cited portion of Matischuk merely refers to “torque-reducing actions” such as gear-switching actions and “torque-increasing actions” such as engine drag. However, the cited portion of Matischuk does not identically disclose the features of ***modifying the at least one output variable . . . starting from the setpoint for the at least one output variable***, as provided for in the context of claim 13. Instead, FIGS. 5a-d of Matischuk plainly indicate that the modification of its drive torque is not starting from the setpoint. Therefore, Matischuk does not identically disclose all of the features as provided for in the context of claim 13, so that it does not anticipate claim 13.

Claims 15, 17, 19, and 22 depend from claim 13 and they are therefore allowable for at least the same reasons as claim 13.

Claim 25 includes features analogous to those of claim 13 and it is therefore allowable for essentially the same reasons as claim 13.

As further regards claim 16, it depends from claim 12 and it further provides that ***the operating variable is a speed of an engine of the drive unit.***

Claims 17, 28, and 29 include features like those of claim 16, except that they depend from claims 13, 24, and 25.

The Office Action refers to various portions of Matischuk (page 4, lines 15 to 20 and page 6, lines 20 to 25) as assertedly disclosing features as provided for in claim 12. In particular, the Office Action refers to the MSETPOINTs and TSETPOINTs of Matischuk as assertedly disclosing *a setpoint for at least one output variable of the drive unit*, and refers to the MSETPOINTRES and TSETPOINTRES of Matischuk as assertedly disclosing *a setpoint for an operating variable of the drive unit in at least one operating state of the drive unit*. As shown in the FIG. 2 of Matischuk, the MSETPOINTs and TSETPOINTs are inputs to a “coordinator 100” from which the MSETPOINTRES and TSETPOINTRES are resulting outputs. The resulting MSETPOINTRES and TSETPOINTRES are inputs to a converter 102. Other than the MSETPOINTRES and TSETPOINTRES, the converter 102 also has inputs 108 through 110.

The resulting MSETPOINTRES and TSETPOINTRES do not correspond to an operating variable that is a speed of an engine of the drive unit, as provided for in the context of the presently claimed subject matter. Indeed, Matischuk merely refers to MSETPOINTRES and TSETPOINTRES as setpoints for resulting torque-setpoint value and its correction time, respectively. Further, Matischuk refers to engine speed as one of the inputs 108 through 110 to the converter 102. The FIG. 2 of Matischuk plainly indicates that the inputs 108 through 110 to the converter 102 are separate and different from MSETPOINTRES and TSETPOINTRES.

Therefore, Matischuk does not identically disclose the features of *specifying a setpoint for an operating variable of the drive unit in at least one operating state of the drive unit, . . . , in which the operating variable is a speed of an engine of the drive unit*, as provided for in the context of claim 16.

Claims 17, 28 and 29 are also allowable for at least the same further reasons as claim 16.

Accordingly, all of claims 12 to 25 are allowable.

New claims 26 to 35 do not add any new subject matter and are supported by the present application. Claims 26 to 35 depend from claims 24 or 25 and are therefore allowable for essentially the same reasons.

Accordingly, all of claims 12 to 35 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

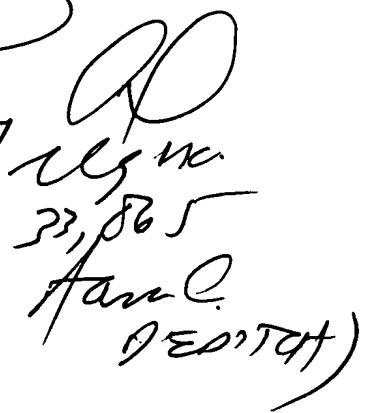
Dated: 9/7/2010

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